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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,550

06/16/2006

Christine Schmid

SCHMID-25

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HENRY M FEIEREISEN, LLC

HENRY M FEIEREISEN

708 THIRD AVENUE

SUITE 1501

NEW YORK, NY 10017

EXAMINER

NICHOLSON, KERI JESSICA

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,550	Applicant(s) SCHMID, CHRISTINE	
	Examiner KERI J. NICHOLSON	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/4/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the initial Office Action based on non-provisional Application 10/596,550 filed June 16, 2006, is the national stage entry of PCT/AT04/00440 filed December 15, 2004 and claims foreign priority from Austria 2027/2003 filed December 17, 2003. An Information Disclosure Statements was received January 4, 2007 and considered May 12, 2008. Claims 1 - 4, as originally filed, were cancelled June 16, 2006 and new claims 5-14, also filed June 16, 2006, are currently pending.

Claim Rejections - 35 USC § 112

1. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation "the recapture member." However, there is insufficient antecedent basis for this limitation in the claim. For examination purposes, claims 12-14 were interpreted to refer to claim 11 where a recapture member is first claimed rather than claim 5.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5-8 are rejected under 35 U.S.C. 102(b) as being unpatentable over Moench et al. (U.S. Patent No. 5,617,877). Moench discloses a structure comprising a shaped body (hollow dome, 20) made of a medically accepted material (column 6, lines 10-16) and having

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bactericide properties (column 10, line 65 – column 11, line 11) for placement in a body cavity (vagina, 92) and against a wall of the body cavity (Fig. 2; column 5, lines 55-61).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moench et al. as applied to claim 5 above in view of Abramson (U.S. Patent No. 3,777,748).

6. Regarding claims 9 and 10, Moench discloses the invention substantially as claimed, as described above, but fails to teach that the structure is made of metal. Abramson discloses an intrauterine device made of metal such as silver (column 4, lines 34-36). At the time the invention was made, it would have been obvious to one having ordinary skill in the art to make the device taught by Moench from silver since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Regarding claims 11 and 12, Moench discloses the invention substantially as claimed, as described above, but fails to teach that the structure further comprises a recapture member. Abramson discloses a thread (filament, 180) attached to an intrauterine device to facilitate the removal of the device from the uterus (column 5, lines 34-39).

8. Regarding claims 13 and 14, the combination of Moench and Abramson discloses the invention substantially as claimed, as described above, but fails to teach that the recapture member is a flexible or silver wire. At the time the invention was made, it would have been an

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obvious matter of design choice to one having ordinary skill in the art to make the intrauterine device taught by Moench as modified by Abramson with a flexible or silver wire since Applicant has not disclosed there is an advantage to flexible or silver wire rather than a thread (filament) and it appears that the invention would perform equally well. Whether using a flexible or silver wire solves any particular problem or produces any unexpected result, the use such a wire is merely a matter of engineering design choice, and thus does not serve to patentably distinguish the claimed invention over the prior art. *In re Kuhle*, 526 f.2d.553, 188 USPQ7 (CCPA 1975). Applicant is also reminded that the argument toward the criticality of an element will generally be given little patentable weight. The basis for criticality should be clearly disclosed in the specification or by affidavit. *In re Cole*, 140 USPQ 230 (CCPA 1964).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Speitling (U.S. Patent Publication No. 2002/0099449) discloses a device for use with therapeutic or surgical equipment with the surface having a layer that releases silver ions having an antibacterial effect since silver is a known material having strongly antiseptic properties (page 1, ¶ 5).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KERI J. NICHOLSON whose telephone number is 571-270-3821. The examiner can normally be reached on Monday - Thursday, 8am-5pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached at 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KJN
/Keri J. Nicholson/
Examiner, Art Unit 3772
5/15/2008

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772